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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,413	08/15/2003	George Y. Huang	Huang/Cont Raised Port	3476
26860	7590	04/20/2007	EXAMINER	
LAW OFFICE OF DUNCAN PALMATIER			TSUKERMAN, LARISA Z	
530 SOUTH ASBURY			ART UNIT	PAPER NUMBER
SUITE 5			2833	
MOSCOW, ID 83843				
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	04/20/2007	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/642,413	HUANG, GEORGE Y.	
	Examiner Larisa Z. Tsukerman	Art Unit 2833	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on RCE and Amendment dt. 03/30/2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Specification*

The amendment filed 03/30/2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C.132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows:

Regarding a new claim 17,

1) By original presentation it was only the product claims. A reason for distinctness between the method and product would be that the structure in the product claims can be made all in one or several manufacturing step, and not two steps as required in the method of Claim 17. The Examiner never examined any method claims and the applicant should not be entitled to now have method claims examined.

2) Specification does not have any support for the following limitation in claim 17, such as "in a first manufacturing step, forming a housing of a material, ... a raised portion is formed ... along with the housing, ... a design surface formed in the background surface wherein the design surface is formed of said material along with the raised portion and the housing, and wherein the design surface is formed as part of the background surface", on contrary Specification discloses:

On (Page 3) "This raised portion of the housing exposes an area where logos or other information can be placed on or molded into the raised portion."

\On (Page 6) "The raised surface 17 provides a place where logos or information may be placed. For example, Fig. 3 shows a completed cable connector with a logo 18 molded into the raised portion 17."

On (Page 8) "As with the cable connector 10 described above, the raised portion 17 of the adapter 27, shown in Fig. 4, may be used as a surface for molded logos or designs 18, labels (not shown), or a gripping surface (not shown)."

All those fragments show that to put any "design" onto the raised portion takes another step and do not formed in the same step with the housing and raised portion.

Also, there is no support "a design surface" claimed in claims 1 and 12.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a), which forms the basis for all obviousness rejections, set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091).

In regard to claims 1and 12, Owens et al. disclose the device comprises the housing 12 formed of a material and having an outer surface (not marked) and at least one end adapted to hold an electrical connector plug, wherein the housing 12 has a raised

portion 26, formed of the material along with the housing (see Fig.4, integral piece from the same material), that is above the outer surface of the housing, a covering 14 formed over the outer surface of the housing 12 and around the raised portion 26, and an exposed part of the raised portion 26 is not covered by the covering; the exposed part of the raised portion 26 further comprises a background surface.

**In regard to claim 17**, Owens et al. disclose a method of manufacturing an electrical connector structure comprising the steps of:

in a first manufacturing step, forming a housing 12 of a material, wherein the housing 12 comprises an outer surface (not marked) and at least one end adapted to hold an electrical connector plug, wherein the outer surface further comprises at least one face, and wherein a raised portion 26 is formed of the material along with the housing (see Fig.4), wherein the raised portion 26 is raised above the face of the outer surface of the housing 12, and wherein the raised portion 26 further comprises side walls extending up from the face and a background surface substantially parallel to the face;

in a second manufacturing step, forming a cover 14 of a second material over the outer surface of the housing 12, wherein the cover 14 is formed around the side walls (not marked, see at 42) of the raised portion 26.

Owens et al. do not discuss the exposed part of the raised portion 26 forms a design surface and is not level with the background surface, which also formed of the material along with the raised portion and the housing, and the design surface is formed as part of the background surface. However, Owens does indicate that the surface of a raised portion 26 is intended for use in applying information (see Col.3, lines 55-56). Etching

and appliqués are both commonly used methods applying info and would have been obvious alternations since they are easily performed. Use of etching or laser technique would result in a design surface that is "not level with the background and also formed of the material along with the raised portion and the housing.

Claims 3 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091) in view of Williams (4256159).

In regard to claims 3 and 14, Owens et al. disclose most of the claimed invention except for a design surface formed in the background surface of the exposed part of the raised portion in a sub-surface design below the background surface formed along with the housing and raised portion of the material.

Williams teaches a design surface 14 below a background surface 13. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a design surface 14 formed in the background surface 13 below the background surface 13, as taught by Williams, in structure of Owens et al. in order to provide some identification information (indicia).

Also, how the design surface arrange, above or bellow the background surface, depend only from the method of forming the design surface by adding or subtracting material.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091) and Williams (4256159), as applied to claim 3 above, and further in view of Biche (4202351).

**In regard to claim 4,** Owens et al. modified by Williams (4256159) include most of invention, except for a design surface formed during molding of the housing. Biche teach a design surface 46, which formed in the background surface 44 by molding with the housing 22 /42 (see Biche, Col.2, line 65 and Col5, line 54). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a design surface 46 formed in the background surface 44 above the background surface 44 in structure of Owens et al., as taught by Biche, in order to provide some identification information (indicia).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091) and Williams (4256159), as applied to claim 3 above, and further in view of Riggs et al. (4275768).

**In regard to claim 5,** Owens et al. modified by Williams disclose most of invention, except for the sub-surface design is formed by machining. Riggs et al. teach a sub-surface design (an engraving indicia) 20 form be engraving. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form a sub-surface design in the background surface in structure of Owens et al. by well-known method of machining/engraving, as taught by Riggs et al., in order to provide some identification information (indicia).

Note: Examiner considers engraving and laser method to form sub-design surface as a machining method.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091) and Williams (4256159), as applied to claim 3 above, and further in view of Beinhaur et al. (4960391).

**In regard to claim 6**, Owens et al. disclose most of the claimed invention except the above-surface design is formed in the background surface of the raised portion of the housing by stamping. Beinhaur et al. teach a well-known method of stamping of the visible indicia (see Col.2, lines 45-46). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form a above-surface design in the background surface in structure of Owens et al. by well-known method as stamping, as taught by Beinhaur et al., in order to provide some identification information (indicia).

Claims 7, 8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091) in view of Biche (4202351).

**In regard to claims 7 and 15**, Owens et al. disclose most of the claimed invention including that the background surface (top surface of 26) formed along with the housing 12 and the raised portion 26 of the material, except for a design surface is a surface formed in the background surface (top surface of 26) above the background surface. Biche teaches (raised indicia "RL", see Fig. 7 and Col.2, lines 65-66) a designed surface 46 formed in the background surface 44 and above the background surface 44. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a design surface 46 formed in the background

surface 44 above the background surface 44 and eventually along with the housing and the raised portion of the material (see claim 1 and above), as taught by Biche, in structure of Owens et al. in order to provide some identification information (indicia).



**In regard to claim 8,** Owens et al. disclose most of the claimed invention except for the above-design surface is formed in the background surface of the raised portion of the housing during molding of the housing. However, Owens et al. modified by Biche include the above-design surface 46, which formed in the background surface 44 of the raised portion of the housing during molding of the housing 22 /42 (see Biche, Col.2, line 65 and Col.5, line 54).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091) in view of Biche (4202351), as applied to claim 7 above, and further in view of Riggs et al. (4275768).

**In regard to claim 9,** Owens et al. modified by Biche disclose most of invention, except for the sub-surface design is formed by machining. Riggs et al. teach a sub-surface design (an engraving indicia) 20 formed by machining (engraving). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form a sub-surface design in the background surface in structure of Owens et

al. by well-known method of machining/engraving, as taught by Riggs et al., in order to provide some identification information (indicia).

Note: Examiner considers engraving and laser method to form sub-design surface as a machining method.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091) and Biche (4202351), as applied to claim 7 above, and further in view of Beinhaur et al. (4960391).

**In regard to claim 10**, Owens et al. disclose most of the claimed invention except the above-surface design is formed in the background surface of the raised portion of the housing by stamping. Beinhaur et al. teach a well-known method of stamping of the visible indicia. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form a above-surface design in the background surface by well-known method as stamping, as taught by Beinhaur et al., in structure of Owens et al. in order to provide some identification information (indicia).

Note: how the design surface arrange, above or bellow the background surface, depend only from the method of forming the design surface by adding or subtracting material

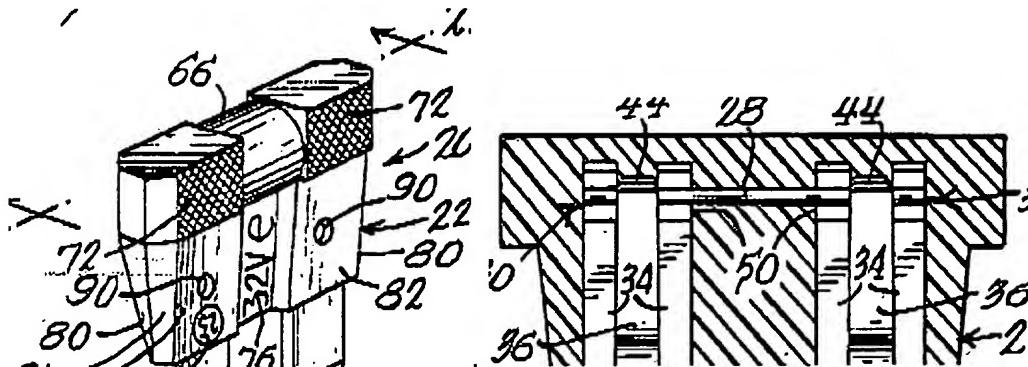
Claims 11 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owens et al. (US004704091) in view of Wiebe (4164725).

**In regard to claims 11 and 16**, Owens et al. disclose most of the claimed invention including that the housing 12 has a raised portion 26 and the background surface (top

surface of the raised portion 26) formed of the material along with the housing, except for a design surface formed in the background surface is a gripping surface design formed along with the housing and raised portion of the material, wherein the gripping surface design comprises ridges.

Wiebe teaches a gripping surface 72 formed of the material along with the background surface (and the housing also, see above) and the gripping surface design comprises ridges. The gripping surface 72 permits one to better grip the component 20 and be more comfortable when hold the device.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form a design surface as a gripping surface in Owens et al., as taught by Wiebe, in order to permit one to better hold the connector.



## **Response to Arguments**

In response to Applicant's Arguments on pages 11-14 regarding claims 1 and 12, where Applicant quotes Owen's reference and states that "In this way, the claims reflect the limitation that the design surface is formed of the same material as the housing, thereby distinguishing the invention from Owens, which teaches the use of a separate

"informative plaque". See Owens, at Abstract ("a final yoke assembly is molded encompassing the ... informational plaque"); see also Col. 1:47-48 ("information plaques molded into the yoke"), Col. 1:59-60 ("a molded contact pin dot information plaque in the yoke"), Col. 3:50-58 ("[i]n forming outer yoke 14, a high grade polymer molding compound flows around and is molded to the inner yoke 12, around color coded alpha-numeric labeling inserts 28a-28n leaving the upper surface of the inserts 28a-28n exposed, around the raised planar informative plaque member 26, and around bottom elongated oval member 36 as illustrated in FIG. 3 also leaving their exterior surfaces exposed"), Col. 4:48-49."

Examiner has to admit that Owens's structure perfectly well show that a housing 12 and a raised portion 26 made of the same material and appear to be a one integral piece (see Fig. 4) formed together. Owen did not disclose that raised portion 26 is a separated piece and disclosure well shows that it is one solid portion, not like portions 28.

Also, Specification disclose:

On (Page 3) "This raised portion of the housing exposes an area where logos or other information can be placed on or molded into the raised portion."

On (Page 6) "The raised surface 17 provides a place where logos or information may be placed. For example, Fig. 3 shows a completed cable connector with a logo 18 molded into the raised portion 17."

On (Page 8) "As with the cable connector 10 described above, the raised portion 17 of the adapter 27, shown in Fig. 4, may be used as a surface for molded logos or designs 18, labels (not shown), or a gripping surface (not shown)."

All those fragments show that to put any indicia/design surface onto the raised portion takes another step and do not form in the same step with the housing and raised portion.

Still, Examiner considers a design surface as ornamentation because any letters, numerals, signs etc. added or subtracted from the main surface are interpreted as ornamentation, and states that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid , 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larisa Z. Tsukerman whose telephone number is (571)-272-2015. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on (571)-272-2800 ex. 33. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LT, 04/09/2007



BRIGGITTE HAMMOND  
PRIMARY EXAMINER